

**REMARKS/ARGUMENTS**

Re-examination and favorable reconsideration in light of the following comments are respectfully requested.

Claims 1 - 14 are pending in the application. Currently, no claim has been allowed.

In the office action mailed August 30, 2005, the Examiner raised a number of objections to the specification. First, the Examiner contends that the specification does not describe how the locations of the coordinates are defined so that one of ordinary skill in the art can make and use same. That is, whether the coordinates are defined relative to the shank axis or the diamond tip axis. Applicant hereby points out that this contention is without merit. One reading the specification and looking at FIG. 2 would understand that the location of the coordinates is defined relative to the shank axis. One of ordinary skill in the art would understand that this is the case because of the depiction of the axis 24.

The Examiner further contends that it is unclear whether Applicant describes an atomic arrangement of atoms in the diamond tip or the angle of the diamond tip 16 with respect to the shank axis. The latter part of the Examiner's contention makes no sense - one of ordinary skill in the art would not read this as a possibility. One of ordinary skill in the art reading the specification in the instant application would understand that Applicant is describing the atomic arrangement of the atoms in the diamond tip.

Still further, the Examiner contends that it is unclear how Applicant defined a diamond having a 90 degree included angle conical point in claim 9 and a diamond having a 120 degree included angle conical point in claim 10. This contention is without merit. One of ordinary skill in the art understands that

the included angle is the angle between the two facets forming the tip. In one case, the angle is 90 degrees and in the other case, the angle is 120 degrees.

Yet further, the Examiner contends that it is unclear what a single crystal diamond is. A single crystal diamond is just that a diamond formed from a single crystal. Such diamonds are known in the art. Attached hereto are excerpts from the Internet which demonstrate that single crystal diamonds are known in the art.

The Examiner further has objected to the drawings as not showing the included angles of claims 9 and 10. This objection is without merit. A diamond having an included angle (the angle between the two facets forming the tip) is illustrated in FIG. 2 as well as in FIG. 1. Since the drawings do not have to be blueprints, the angles do not have to be precisely drawn. Applicant's depiction of the included angle is sufficient to comply with the requirements of 37 C.F.R. 1.83(a). However, to help the Examiner out, Applicant has amended FIG. 2 to show the included angle  $\alpha$ . Paragraph 0020 has been amended to reflect this drawing change. No new matter has been added. The Examiner is hereby requested to approve the drawing amendment. Attached hereto is a copy of the Diamond Knife Manual to show that Applicant's depiction of the included angle is correct.

Claims 1 - 14 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner contends that regarding claims 1, 13, and 14, it is unclear whether Applicant claims atomic arrangement of the atoms in the diamond tip 16 or the angle of the diamond tip 16 with respect to the shank axis 24 or the angle of the outer surface of the diamond tip with respect to the diamond tip's axis or the diamond tip's base. The Examiner contends that there is

insufficient information as to the specific intrinsic crystallographic direction and the angle to what it is. That is, it is not clear what the <17, 12, 24> direction represents. The Examiner further states that "it is not clear why mounting of any diamond tip to an indenting tool would not inherently meet the limitation of the direction of the diamond tip, since the Applicant's diamond tip is very similar to other diamond tips which both align with the axis of their shank and both have conical shape.

With regard to the latter statement, this is not a basis for making a rejection under 35 U.S.C. 112, first paragraph. It may form a basis for a prior art rejection, but it certainly does not form the basis for a non-enablement rejection. The fact that Applicant's diamond tip is similar to others goes to prior art, not to enablement.

With regard to the enablement rejection, the Examiner has not made out a *prima facie* case of non-enablement since there is no statement as to why one of ordinary skill in the art having the teachings contained in the specification and drawings could not make and use the claimed invention. As stated in *In re Armbruster*, 185 USPQ 152, 153 (CCPA 1975), quoting from *In re Marzocchi*, 169 USPQ 367, 369-70 (CCPA 1971), "it is incumbent upon the Patent Office, whenever a rejection on this basis [lack of enablement] is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." The Examiner has not provided any evidence or any reasoning why one of ordinary skill in the art having the instant disclosure before him could not make or use the claimed invention. The mere fact that the Examiner is having difficulty understanding the

claimed subject matter is not a basis for a lack of enablement rejection. The standard is one of ordinary skill in the art and the Examiner is not one of ordinary skill in the art. In Applicant's opinion, the specification contains sufficient guidance so that one of ordinary skill in the art could make and use the claimed invention without undue experimentation. See Applicant's comments regarding the objection to the specification. Even if some experimentation were needed, and Applicant believes none is needed, such experimentation would be permissible. See *Ex parte Jackson*, 217 USPQ 804, 807 (BPAI 1982); also see *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 94 (Fed. Cir. 1986). Where a specification such as the instant one provides guidance in selecting parameters that would yield the claimed result as well as a lot of other details, it is fair to conclude that the experimentation required to make a particular embodiment is not "undue". See *In re Colianni*, 195 USPQ 150, 153 (CCPA 1977); also see *In re Wands*, 8 USPQ2d 1400, 1406 (Fed. Cir. 1988). For these reasons, the rejection under 35 U.S.C. 112, first paragraph should be withdrawn.

With regard to the rejection of claims 1, 13, and 14 under 35 U.S.C. 112, this rejection should also be withdrawn. When one reads the claims in light of the specification, the term <17, 12, 24> is crystal clear. There is no confusion with the shank 12 and/or the shank axis 24. The Examiner has offered no reason why one of ordinary skill in the art would be confused.

With regard to the rejection of claims 1 - 6, and 8 - 14 on anticipation grounds over U.S. Patent No. 6,051,079 to Anderson, it is well settled that in order for a reference to anticipate a claim, it must contain all the features called for in the claim. Anderson does not teach or suggest a diamond being mounted to

the tip and within 8 degrees of a <17,12,24> direction as claimed in claims 1, 13, and 14. Anderson is silent on crystallographic orientation of the diamond. What an Examiner considers the reference to show is not relevant. What is significant is what the reference discloses to one of ordinary skill in the art. Anderson does not disclose the claimed invention.

Claims 2 - 6 and 8 - 12 are allowable for the same reasons as their parent claim(s) as well as on their own accord.

With regard to the rejection of claim 7 on obviousness grounds, claim 7 is allowable for the same reason as well as its own accord. Further, the mere fact that something is known in the art is not a basis for concluding something is obvious. The Examiner provides no secondary reference that teaches or suggests the use of a synthetic single crystal diamond. Still further, the Examiner has not provided any statement as to why one of ordinary skill in the art would be motivated to use a synthetic single crystal diamond. Thus, the rejection is fatally flawed.

For the foregoing reasons, the instant application is believed to be in condition for allowance. Such allowance is respectfully solicited.

Should the Examiner believe an additional amendment is needed to place the case in condition for allowance, the Examiner is hereby invited to contact Applicants' attorney at the telephone number listed below.

Appl. No. 10/718,086  
Amdt. dated Nov. 30, 2005  
Reply to office action of Aug. 30, 2005

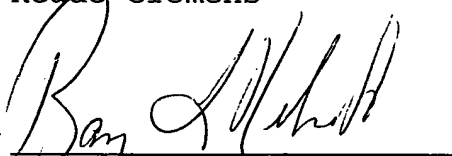
Docket No.: EH-10546A(01-465A)

No fee is believed to be due as a result of this response.  
Should the Director determine that a fee is due, he is hereby  
authorized to charge said fee to Deposit Account No. 21-0279.

Respectfully submitted,

Reade Clemens

By

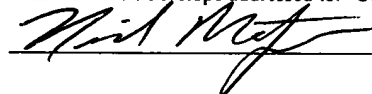


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Date: November 30, 2005

I, Nicole Motzer, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on November 30, 2005.



**Amendments to the Drawings:**

The attached sheet of drawings includes changes to FIG. 2. This sheet, which includes FIGS. 1 and 2, replaces the original sheet including FIGS. 1 and 2. In FIG. 2, the symbol  $\alpha$  has been added along with the lines which show the included angle.

Attachments:    Replacement Sheet  
                  Annotated Sheet Showing Changes